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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/336,266 06/14/99 BEMIS G VPI/96-16.CI

HM12/0525

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EXAMINER

RAD, D

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 05/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/336,266

Applicant(s)

Bemis et al.

Examiner

Deepak Rao

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/15/01 and 3/20/01
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-12, 15, and 18-38 are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-12, 15, and 18-38 are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 20) ☐ Other: _____

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DETAILED ACTION

Claims 38, 4-12, 15 and 18-37 are pending in this application.

Priority

The continuing data presented in 'cross reference to related applications' is acknowledged. The oath/declaration indicates that the instant application claims benefit under 35 U.S.C. 120 from PCT/US97/23392 filed December 17, 1997, which claims benefit from the applications stated in the first paragraph of the specification. However, the continuing data does not include the information of the PCT application. Appropriate correction or clarification is required.

The following rejections are withdrawn:

The rejections under 35 U.S.C. 112, first and second paragraphs of the previous office action are hereby withdrawn in view of the amendments, remarks and the Declarations under 37 CFR 1.132 by Dr. Salituro and Dr. Bemis.

The following rejections are necessitated by the amendments:

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 38, 4-12, 15 and 18-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1. In claim 38, the structural formulae (Ie) - (Ih) do not contain a variable 'Y', however, the claim provides a definition for Y, see page 23, line 23. Deletion of the definition "Y is C;" is suggested. p
2. Claim 15 recites the limitation "each R attached to Y" in line 2. There is insufficient antecedent basis for this limitation in claim 38 on which claim 15 is dependent. The formulae disclosed in claim 38 do not contain Y to which R is attached. Deletion of "attached to Y" from line 2 would obviate this rejection. p
3. Claim 22 recites the limitation "formula Ie" in line 2, discloses the formula at line 3 and further discloses compounds # 203-207 in the table at lines 4+. There is insufficient antecedent basis for these limitations in claim 38 on which claim 22 is dependent.
 - (a) The formula (Ie) disclosed in claim 38 does not contain the variable Y. p
 - (b) The compounds # 203-207 disclosed in claim 22 contain 1,2-diazine rings whereas claim 38 is drawn to pyridyl compounds (see formula (Ie) wherein A is CR').

Replacing the structural formula (Ie) consistent with claim 38 and deletion of compounds # 203-207 is suggested.


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4. Claim 23 recites the limitation "formula Ig" in line 2, discloses the formula at line 3 and further discloses compounds # 384 on page 14. There is insufficient antecedent basis for these limitations in claim 38 on which claim 23 is dependent.

(a) The formula (Ig) disclosed in claim 38 does not contain the variable Y. 

(b) The compound # 384 disclosed in claim 23 contains 1,4-diazine ring whereas claim 38 is drawn to pyridyl compounds (see formula (Ig) wherein A is CR').

Replacing the structural formula (Ig) consistent with claim 38 and deletion of compound # 384 is suggested.

5. Claim 24 recites the limitation "formula Ih" in line 2, discloses the formula at line 3 and further discloses compounds # 412 on page 18. There is insufficient antecedent basis for these limitations in claim 38 on which claim 24 is dependent. 

(a) The formula (Ih) disclosed in claim 38 does not contain the variable Y.

(b) The compound # 412 disclosed in claim 24 contains 1,4-diazine ring whereas claim 38 is drawn to pyridyl compounds (see formula (Ih)).

Replacing the structural formula (Ih) consistent with claim 38 and deletion of compound # 412 is suggested.

Claims not particularly addressed above are included in the rejection because they are dependent claims and do not further resolve the above issues.

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The following rejections are under new grounds:

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by **another** who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

1. Claims 38, 4-12, 15 and 18-20, 23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Bemis et al., U.S. Patent No. 5,945,418 (U.S.S.No. 08/862,925). The instantly claimed compounds read on the compound disclosed in the reference, see the compound in col. 25, lines 22-35, which is identical to the compound # 309 in claim 23.


2. Claims 38, 4-12, 15, 18-20, 22-23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Bemis et al., U.S. Patent No. 6,147,080 (U.S.S.No. 08/822,373). The instantly claimed compounds read on the reference compounds, see the compound in col. 31, lines 34-45 (identical to compound # 309 of claim 23), col. 35, compound 201 (identical to compound # 201 of claim 22) and col. 39, compound 202 (identical to compound # 202/301 of claim 23).


Note: It is acknowledged that the instant application is a CIP of 08/862,925 filed June 10, 1997 which is a CIP of 08/822,373 filed March 20, 1997 which claims benefit of U.S. Provisional Application S.No. 60/034,288 filed December 18, 1996. It is noted however, that the instant claims are not entitled for the above priority date(s) because the

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instantly claimed invention is not fully supported in the prior applications, see the definitions of Q_3 , Q_2 , etc. in the instant claims wherein several of the substituent groups are not disclosed in the previous applications. For example, the substituents of Q_3 include 'N(R')C(O)R₄; N(R')C(O)OR₄; N(R')C(O)C(O)R₄;...' in the instant claims which are not disclosed in the prior applications (as can be seen from the definition of Q_1 in col. 2 of US'418 or US'080). Therefore, the instant claims are not entitled for the earlier date(s). See MPEP § 706.02.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The fax phone number for this Group is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Deepak Rao 
May 24, 2001


Mukund J. Shah
Supervisory Patent Examiner
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